

EXHIBIT 6

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FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER L.L.P.  
CHARLES E. LIPSEY (*In Pro Hac Vice*)  
EDNA VASSILOVSKI (*In Pro Hac Vice*)  
THOMAS W. BANKS (195006)  
JOHN W. BURNS (190031)  
700 Hansen Way  
Palo Alto, CA 94304  
Telephone: (650) 849-6600  
Facsimile: (650) 849-6666

WRIGHT & L'ESTRANGE  
JOHN H. L'ESTRANGE, JR. (49594)  
JOSEPH T. ERGOSTOLO (137807)  
701 B Street, Suite 1550  
San Diego, CA 92101  
Telephone: (619) 231-4844  
Facsimile: (619) 231-6710

Attorneys for Defendant VYSIS, INC.

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,  
  
Plaintiff,  
  
v.  
  
VYSIS, INC.,  
  
Defendant.

No. 99CV2668 H (AJB)

DECLARATION OF NORVAL B. GALLOWAY

Date: September 15, 2000  
Time: 9:30 a.m.  
Dept.: Courtroom A

I, Norval B. Galloway, declare:

1. I am Patent Counsel for Vysis, Inc., the defendant in the present litigation between Gen-Probe Incorporated (Gen-Probe) and Vysis, Inc. (Vysis).

2. Vysis is a small company with limited financial resources. Vysis employs only two in-house lawyers, its general counsel and me. I am Vysis's in-house patent attorney and the only attorney at Vysis with detailed familiarity with the patent-in-suit, U. S. Patent No. 5,750,338 (the '338 patent), its history, and the technical subject matter and issues involved in this suit. I am also the only attorney at Vysis with detailed familiarity with the '338 patent reissue application now before the Patent Office. There is no one else at Vysis who can knowledgeable and efficiently

COPY

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CLERK OF DISTRICT COURT

BY: \_\_\_\_\_  
DEPUTY



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1 interact with Vysis's outside counsel in these two proceedings involving the '338 patent. I believe  
2 my participation in both proceedings involving the '338 patent is critical to protecting the interests of  
3 Vysis and instructing outside counsel in those cases.

4 3. Vysis and Gen-Probe, parties in the present suit, were previously both parties in Case  
5 No. 95-CV-998-J (BTM), a patent infringement suit also filed in the Southern District of California.  
6 That case was filed by Gen-Probe alleging that the activities of Vysis in a number of areas, including  
7 assays for infectious diseases, infringed Gen-Probe's patents. The parties stipulated to a protective  
8 order in the case that specifically allowed both Vysis and Gen-Probe to designate an in-house  
9 attorney and two officers, directors or employees with free access to all of the opposing parties'  
10 confidential information. All attorneys of record also had full access to confidential information  
11 produced in discovery. Gen-Probe did not try to restrict access to confidential information by any of  
12 Vysis's in-house counsel or its corporate officers, or impose any restriction on patent prosecution  
13 activity. A copy of that protective order is attached as Exhibit A. Gen-Probe has not accused Vysis  
14 of violating the previous protective order or of misusing Gen-Probe's confidential information from  
15 that case.

16 4. The previous case settled on August 10, 1999. The terms of the settlement effectively  
17 prohibit Vysis from competing with Gen-Probe in the field of infectious disease testing. The terms  
18 prohibit Vysis from using tests it developed to compete with Gen-Probe for the detection of  
19 infectious diseases. Vysis has never competed in the blood screening field in which the Gen-Probe  
20 NAT test kit products that are the subject of this action compete.

21 5. As an additional condition of settling the previous patent infringement lawsuit, Gen-  
22 Probe insisted upon a license under Vysis's '338 patent, one of the Collins patents, the patent-in-suit.  
23 Three letters between the parties discussing the settlement, two dated March 29, 1999 and one dated  
24 April 9, 1999, are attached to this declaration as Exhibits B, C and D.

25 6. On December 22, 1999, just three and one-half months after the previous suit was  
26 settled, Gen-Probe filed this new lawsuit against Vysis, asking for declaratory judgment that the '338  
27 patent is invalid or not infringed, and to excuse Gen-Probe from paying royalties due under the  
28 license.

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1           7.     On March 8, 2000, Vysis filed a patent reissue application with the PTO for the '338  
2 patent based on a belief that the patent is partially inoperative for failure to assert claims of  
3 intermediate scope. The new claims that Vysis proposes to add to the patent through the reissue  
4 process are narrower than the broadest claims in the original patent and do not cover subject matter  
5 outside that already encompassed by the original patent claims. The reissue proceeding is being  
6 conducted on the public record to which the public has full access. Gen-Probe has been provided  
7 with a copy of the reissue application. I understand Gen-Probe has filed a protest to the application  
8 with the PTO.

9           8.     Vysis is represented in this litigation by outside counsel, Finnegan, Henderson,  
10 Farabow, Garrett & Dunner (Finnegan Henderson) and specifically by Charles E. Lipsey. It has  
11 retained Wright & L'Estrange as local counsel to assist Finnegan Henderson with local procedures.  
12 Mr. Lipsey has substantial familiarity with the '338 patent and the relevant technology. His  
13 participation in both this litigation and the patent reissue proceeding are essential for protecting  
14 Vysis's legal interests. Neither Finnegan Henderson, Wright & L'Estrange, nor any of their  
15 attorneys or staff do any patent prosecution for Vysis other than the application to reissue the '338  
16 patent.

17           9.     Apart from the reissue application, Finnegan Henderson does not represent Vysis in  
18 patent prosecution matters. Finnegan Henderson has no general familiarity with Vysis' portfolio of  
19 intellectual property and provides no regular advice to Vysis with respect to Vysis' research,  
20 development, and business activities. To the contrary, Vysis regularly is represented by a number of  
21 firms other than Finnegan Henderson for patent prosecution and business matters. Finnegan  
22 Henderson's representation of Vysis is limited to adversarial matters such as this litigation and issues  
23 relating to them. Finnegan Henderson has previously represented Vysis in matters involving  
24 Gen-Probe, including the prior litigation identified in paragraph 3 above. Finnegan Henderson  
25 became familiar with the '338 patent and the history of this case as a result of that prior  
26 representation. Thus, I believe it is essential for Vysis that Finnegan Henderson represents Vysis  
27 with respect to the reissue application as well as this lawsuit.

28



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	<u>Exhibit</u>	<u>Description</u>	<u>Page</u>
1			
2	A	November 24, 1995 Stipulated Protective Order re Confidential Information in <u>Gen-Probe, Inc. v. Amoco Corp.</u> , Case No. 95-CV-998-J (BTM).	6
3			
4	B	March 29, 1999 letter from J.L. Bishop to H.L. Nordhoff.	20
5	C	March 29, 1999 fax letter from H.L. Nordhoff to J.L. Bishop.	24
6	D	April 9, 1999 letter from J.L. Bishop to H.L. Nordhoff.	29
7	E	July 31, 2000 letter from Thomas W. Banks to Patrick M. Maloney.	31
8	F	August 3, 2000 letter from Patrick M. Maloney to Thomas W. Banks.	33
9			
10	G	June 20, 2000 Gen-Probe's responses to Vysis' Second Set of Requests for Production of Documents.	37
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7. 11-1-1136  
**FILED**  
 24 1995  
 CLERK U.S. DISTRICT COURT  
 SOUTHERN DISTRICT OF CALIFORNIA  
 BY *[Signature]*

1 LYON & LYON  
 A Partnership Including  
 2 DOUGLAS E. OLSON (State Bar No. 38649)  
 A Professional Corporation  
 3 MARY S. CONSALVI (State Bar No. 130966)  
 MATTHEW W. KNIGHT (State Bar No. 150209)  
 4 F.T. ALEXANDRA MAHANEY (State Bar No. 125984)  
 4250 Executive Square, Suite 660  
 5 La Jolla, California 92037  
 (619) 552-8400  
 6

7 Attorneys for Plaintiff  
 GEN-PROBE INCORPORATED  
 8  
 9

10 UNITED STATES DISTRICT COURT  
 11 FOR THE SOUTHERN DISTRICT OF CALIFORNIA  
 12

13	GEN-PROBE INCORPORATED, a	)	Case No. 95-CV-998-J (BTM)
14	Delaware Corporation	)	
15	Plaintiff,	)	
16	v.	)	STIPULATED PROTECTIVE ORDER RE
17	AMOCO CORPORATION, an Indiana	)	CONFIDENTIAL INFORMATION
18	Corporation, AMOCO TECHNOLOGY	)	
19	COMPANY, a Delaware	)	
20	Corporation, GENE-TRAK SYSTEMS,	)	
21	INC., a Delaware Corporation,	)	
22	and VYSIS, INC., a Delaware	)	
23	Corporation,	)	
24	Defendants.	)	

23 WHEREAS, the discovery and pretrial phase of this action will  
 24 involve disclosure of trade secrets and other confidential and  
 25 proprietary business, technical and financial information, the  
 26 parties hereby stipulate and request that the Court enter the  
 27 following order pursuant to Rule 26(c) of the Federal Rules of  
 28 Civil Procedure:

DOBBED "S05EE560  
 & LYON  
 4250 EXECUTIVE SQUARE, SUITE 660  
 LA JOLLA, CA 92037  
 (619) 552-8400

*cm*  
*11/24/95*  
*[Signature]*

SSSD/915. v01

55  
 Exhibit A  
 6





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LYON\_YON  
4250 EXECUTIVE SQUARE, SUITE 660  
LA JOLLA, CA 92037  
(619) 552-8400

~~1 before any court, agency or tribunal as evidence of or concerning  
2 whether or not such information is confidential or proprietary.~~

3       17. Return of Information. At the conclusion of this action  
4 whether by judgment and exhaustion of all appeals, or by  
5 settlement, all Confidential Information and all documents which  
6 reflect such information shall be (i) delivered to the party that  
7 furnished such Confidential Information, or (ii) in lieu of  
8 delivery to the furnishing party, destroyed, in which event counsel  
9 shall give written notice of such destruction to opposing counsel.  
10 The attorneys of record shall insure that all the Confidential  
11 Information in the possession, custody or control of their experts  
12 and consultants is also destroyed or returned to the party that  
13 furnished such Confidential Information. In no event shall a  
14 party, their experts or consultants retain a copy of Confidential  
15 Information produced to it.

16       18. Court's Jurisdiction. The Court retains jurisdiction to  
17 make such amendments, modifications, deletions and additions to  
18 this Order as the Court may from time to time deem appropriate.  
19 The provisions of this Order regarding the use and/or disclosure of  
20 Confidential Information and Confidential -- For Counsel Only  
21 information shall survive the termination of this action, and the  
22 Court shall retain jurisdiction with respect to this Order.

23       19. Jurisdictional Effect. An entity's stipulation to this  
24 Protective Order shall have no effect on that entity's right to  
25 file a motion under Fed. R. Civ. P. 12 or challenge this Court's  
26 jurisdiction over said entity.

27 ///  
28 ///

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LYC LYON  
4250 EXECUTIVE SQUARE, SUITE 660  
LA JOLLA, CA 92037  
(619) 552-8400

1 20. Third Party Rights. This order is without prejudice to  
2 the rights of any third party.

3 LYON & LYON

4  
5  
6 Dated: Oct 20 1995

By: Mary S. Consalvi  
MARY S. CONSALVI  
Attorneys for Plaintiff,  
GEN-PROBE INCORPORATED

7  
8  
9 FINNEGAN, HENDERSON, FARABOW,  
10 GARRETT & DUNNER

11  
12 Dated: ~~October 20, 1995~~ November 8, 1995

By: Gerson S. Panitch  
GERSON S. PANITCH  
Attorneys for Defendants,  
AMOCO CORPORATION, AMOCO TECHNOLOGY  
13 COMPANY, GENE-TRAK SYSTEMS, INC.  
14 and VYSIS, INC.

15  
16 WRIGHT & L'ESTRANGE

17  
18  
19 Dated: Nov. 10, 1995

By: John H. L'Estrange Jr  
Co-Counsel for Defendants,  
20 AMOCO CORPORATION, AMOCO TECHNOLOGY  
21 COMPANY, GENE-TRAK SYSTEMS, INC.  
22 and VYSIS, INC.

23  
24 **ORDER**

25 IT IS SO ORDERED as modified in writing by the Court

26  
27 Dated: November 28  
~~October~~, 1995

[Signature]  
UNITED STATES DISTRICT JUDGE  
Magistrate

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EXHIBIT B



March 29, 1999

BY FACSIMILE

Gen-Probe Incorporated  
10210 Genetic Center Drive  
San Diego, CA 92121-4362

Attention: H.L. Nordhoff, President &  
Chief Executive Officer

Settlement Proposal

Dear Hank:

Thank you for meeting with us last Wednesday. We remain hopeful that an acceptable settlement can be found so that our companies can get on with their main business activities. Thus, as agreed, we have developed the attached alternative settlement proposal for your review and consideration.

We look forward to receiving Gen-Probe's proposal.

Best regards,

J.L. Bishop,  
President and CEO  
Attach.

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AMOCO SETTLEMENT PROPOSAL

A. PATENT CASES

1. The Amoco defendants will agree not to challenge directly or indirectly the validity of the Kohne '330 and '611 patents in the future.
2. Gen-Probe will agree not to challenge directly or indirectly the validity of the Vysis Listeria patent in the future.
3. Gen-Probe will grant Vysis a limited worldwide, nonexclusive, royalty-free immunity from suit for assays for detecting or quantifying ribosomal nucleic acids for food testing applications covered by any claim of the Kohne '330 or '611 patents.
4. Vysis will grant Gen-Probe a worldwide, nonexclusive, royalty-free license under the Listeria patent.
5. Gen-Probe will release the Amoco defendants for alleged past infringement of Gen-Probe patents and dismiss its pending causes of action in the patent case.
6. Vysis will release Gen-Probe for all claims of alleged past infringement of Vysis patents and dismiss its pending causes of action in the patent case.

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C. MALICIOUS PROSECUTION CASES

11. Amoco will pay Gen-Probe, in addition to the considerations listed above, \$1 million and Kohne \$250,000.

12. Kohne, Gen-Probe and Chugai will grant a general release, including a release of unknown claims, associated with prosecution of the UC and CNS cases and dismiss with prejudice the pending malicious prosecution actions.

D. GENERAL PROVISIONS

13. The licenses and/or immunities provided under the agreement would be transferable only with the sale of the business or of substantially all of the assets to which the business relates. The discounted royalty rate specified in paragraph 9 is personal to Gen-Probe. In the event of the sale of Gen-Probe's business or of substantially all of Gen-Probe's assets to which Gen-Probe's business relates, any surviving license under the Stanbridge patent will include a running royalty of 5%.

14. The terms of the settlement shall be confidential except that the terms of the licenses and/or immunities granted may be disclosed by a party to the extent necessary to comply with applicable securities laws.

Exhibit B  
23

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**EXHIBIT C**



BAK-29-99 MON 17:55

FAX NO.

1901

P.01

*C. Files*

*Settlement Disc*

*WGP.*

**GEN-PROBE INCORPORATED**

10210 Ceramic Center Drive, San Diego, CA 92121  
Phone: (619) 410-8902 Fax: (619) 410-8901

Facsimile

Date: March 29, 1999

To: John L. Bishop

From: H. L. Nordhoff

Fax: 630 271 7078

Pages to Follow: 2

Message:

Dear John:

Attached please find our proposal. I know you will give it serious consideration for we are both anxious to get back to business and grow our respective companies. The terms should be viewed together.

I look forward to hearing from you and doing our best to settle this matter.

Sincerely,

*H. L. Nordhoff*  
H. L. Nordhoff

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Exhibit C

24

**CONFIDENTIAL NOTICE**

The information contained in this facsimile message is confidential information intended only for use of the addressee(s) named above. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering this message to the intended recipient, please note that any distribution or copying of this communication is strictly prohibited. Anyone who receives this communication in error, should notify us immediately by telephone, and return the original message to us at the above address via the U.S. Postal service.

Transmission Problems (619) 410-8903

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**OUTLINE OF SETTLEMENT TERMS PROPOSED BY GEN-PROBE**

**Resolution of litigation**

- GP withdraws its patent infringement suit against Amoco/Vysis and releases Amoco/Vysis from claims of past infringement.
- Amoco/Vysis withdraw their patent infringement counterclaim against GP and release GP from claims of past infringement.
- GP withdraws its malicious prosecution suit against Amoco/Vysis and releases Amoco/Vysis from all claims therein in return for a cash payment of \$10 million from Amoco/Vysis to GP.
- Amoco/Vysis agree to withdraw from active participation in pending oppositions to the Kohne European patents, including the pending EPO appeal, and agree not to initiate any future proceedings (directly or through any third party) or to induce any third party to initiate any proceedings or provide assistance to any third party in proceedings in any countries challenging the validity or GP's ownership of the Kohne patent rights or any other patent rights of GP relating to the use of nucleic acid probes to detect ribosomal RNA.
- Amoco/Vysis stipulate to the validity of all claims in issued Kohne patents worldwide and stipulate that GP is the rightful legal owner of all Kohne patent rights.

**Exchange of intellectual property rights**

- GP grants Amoco/Vysis a paid-up, royalty-free, non-exclusive, worldwide license under any claim of the Kohne '330 or '611 patents solely for use in the field of food testing.
- Amoco/Vysis grant GP a paid-up, royalty-free, non-exclusive, worldwide license under any patents owned or controlled by Amoco/Vysis that are directed to the detection of Listeria, including without limitation Stackebrandt.
- Amoco/Vysis grant GP a paid-up, non-exclusive, royalty-free, worldwide license under Collins patents in return for a payment of \$5 million.
- Amoco/Vysis grant GP a paid-up, non-exclusive, royalty-free, worldwide sublicense under the Stanbridge patent in consideration of one dollar and other considerations recited herein.
- GP receives a life-of-patent option for a non-exclusive, worldwide license under all Amoco/Vysis patents covering probes for detection of ribosomal RNA sequences. GP may exercise such option with respect to individual patents or groups of patents. Such licenses shall be royalty free for any patent based on an application having an effective filing date after July 25, 1989 and shall bear a commercially reasonable royalty not to exceed 2%, to be negotiated in good faith, for any patent based on an application having an effective filing date before July 25, 1989.

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- All licenses granted herein may be sublicensed by the licensee to an affiliate or commercial collaborator or for use in connection with other significant out-licensed technology (provided, that neither party may sublicense such rights to an existing collaborator or licenses of the party granting such license) and may be assigned only in connection with a sale or transfer of essentially all of the licensee's business.

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w/CPilas  
GP Settlement Disc

April 9, 1999

BY FACSIMILE

Gen-Probe Incorporated  
10210 Genetic Center Drive  
San Diego, CA 92121-4362

Attention: H.L. Nordhoff, President &  
Chief Executive Officer

Settlement Negotiations

Dear Hank:

We remain interested in pursuing resolution of the various issues pending between our firms. I would like to see if that can be done now that we have already found agreement to some of the patent issues and now that Judge Prager seems to have finalized his ruling on Amoco's Motion for Summary Judgment in the malicious prosecution case. I understand, for example, that Gen-Probe's counsel acknowledged to Judge Prager at the hearing Wednesday that the case was brought to provide Gen-Probe with additional leverage regarding the outstanding patent issues. Although we did not see that the case strengthened Gen-Probe's position, Judge Prager's recent rulings should confirm that any additional leverage and any corresponding damage recovery that Gen-Probe might have expected from it are simply not forthcoming.

At the same time, I think we have already found resolution to many substantial issues regarding our respective patents. Vysis will agree, for example, to forego activities in clinical diagnostics utilizing ribosomal nucleic acids. We will also agree to make our probe library available to Gen-Probe. I think you would agree these represent substantial concessions on our part. In return, Gen-Probe has indicated it will provide us with freedom to operate our Gene-Trak food diagnostics business. Finally, Vysis can also agree that the Collins and Stanbridge patents can be separated from consideration and settlement of the pending litigations. Again, we believe this should simplify matters rather than complicate them.

I had understood that Gen-Probe had decided that further settlement discussions would be unproductive. However, I understand now from Bill's recent letter to Tom Ryan, that Gen-Probe is agreeable to further discussions albeit without Judge Prager's assistance. As I said earlier, we remain interested in resolving the issues between our firms. Given the present postures of the cases and the substantial agreement already reached, we believe further discussions will be useful. And, as you and I agreed during our last meeting in San Diego, it would be far better for each of us to resolve the litigations so that we can refocus our attention on our own businesses.

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April 9, 1999  
Gen-Probe Incorporated  
Page 2

I look forward to your suggestions as to how best to proceed.

Best regards,



J.L. Bishop,  
President and CEO

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April 9, 1999  
Gen-Probe Incorporated  
Page 2

I look forward to your suggestions as to how best to proceed.

Best regards,



J.L. Bishop,  
President and CEO

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EXHIBIT E

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

STANFORD RESEARCH PARK  
700 HANSEN WAY  
PALO ALTO, CALIFORNIA 94304

TELEPHONE 650-849-6600  
FACSIMILE 650-849-6666

WRITER'S DIRECT DIAL (650) 849-6630  
THOMAS.BANKS@FINNEGAN.COM

WASHINGTON  
202-408-4000

ATLANTA  
404-633-6400

TOKYO  
011-81-3-3431-8943

BRUSSELS  
011-322-646-0353

July 31, 2000

VIA FACSIMILE

Patrick M. Maloney, Esq.  
Cooley Godward LLP  
4365 Executive Drive  
Suite 1100  
San Diego, CA 92121-2128

Re: Gen-Probe Incorporated v. Vysis, Inc.

Dear Pat:

Thank you for your July 28, 2000 letter summarizing our telephonic meet and confer of July 26, 2000. For the most part, your letter accurately reflects our discussion. There is, however, one inaccuracy. It is my recollection that you agreed to consider whether the "or associated with" language in paragraph 5(f) of the proposed Protective Order could be removed. Please let me know if you disagree.

In our follow-up July 28, 2000 meet and confer, we discussed whether the parties might agree to a specified person or persons who would have access to Gen-Probe Confidential or Confidential-Attorneys Only information and who would not be precluded from assisting in the prosecution of the '338 patent reissue application. Vysis will consider this possibility.

We also discussed in the July 28 meet and confer Gen-Probe's responses to Vysis document requests. Specifically, we discussed Gen-Probe's responses limiting Gen-Probe's production of documents to its NAT test kits for HCV or HIV. See Gen-Probe responses to requests 3-5, 7, 21, 23-25 and 31-41. You stated your belief that the declaratory judgment complaint related only to HCV and HIV products and that these two were the only imminent commercial NAT kit products. I asked whether Gen-Probe would further amend its complaint if during the pendency of the litigation Gen-Probe introduced NAT test kits for other products. You said you would consider this question.

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Patrick M. Maloney, Esq.  
Cooley Godward LLP  
July 31, 2000  
Page 2

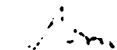
We also discussed Gen-Probe's objection to producing documents broadly relating to its NAT test kits for HCV or HIV and its response that it would produce "a complete set of non-privileged design specification documents concerning the design and method of operation of such documents." See Gen-Probe responses to Vysis document requests 3-5, 7, 9, 21, 23, and 42-43. We discussed whether Gen-Probe would produce only the final design specification documents or would produce all preliminary design specifications created during product development. We also discussed whether responsive research and development documents such as laboratory notebooks would be produced. You said you would consider these issues.

Finally, we discussed Gen-Probe's response to Document Request No. 6 and whether or not it will produce a sample of its NAT test kits for use in detecting HCV and HIV to Vysis under the terms of the Protective Order. You also wanted to consider this matter further.

We agreed that the parties will not raise issues regarding the scope of discovery with Magistrate Battaglia tomorrow. You raised the notion that we might want to obtain the magistrate's views on issues relating to the Protective Order, particularly paragraph 5. As we discussed on Friday, we are presently doing legal research on issues raised by paragraph 5 and will consider the cases you brought to our attention. After we complete the legal research, we will consider a compromise to your proposed paragraph 5. This is an important issue for Vysis because it impacts Vysis's ability to defend this lawsuit and to effectively prosecute the reissue application. Accordingly, we will most likely not be in a position to propose any alternative to paragraph 5 until the end of this week.

Please let me know if I have misstated or misunderstood any point from our meet and confer discussions. I'd like to thank you and Matt for the spirit of cooperation displayed during these discussions.

Sincerely,



Thomas W. Banks

TWB/sls

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EXHIBIT F

**Cooley Godward LLP**

ATTORNEYS AT LAW

4365 Executive Drive  
Suite 1100  
San Diego, CA  
92121-2128  
Main 858 550-6000  
Fax 858 453-3555

Boulder, CO  
303 546-4000  
Denver, CO  
303 606-4800  
Kirkland, WA  
425 893-7700  
Menlo Park, CA  
650 843-5100  
Palo Alto, CA  
650 843-5000  
Reston, VA  
703 262-8000

PATRICK M. MALONEY  
858 550-6083  
maloncpm@cooley.com

San Francisco, CA  
415 693-2000

August 3, 2000

VIA FACSIMILE

Thomas W. Banks, Esq.  
Finnegan, Henderson, Farabow, et al.  
700 Hansen Way  
Palo Alto, CA 94304

Re: Gen-Probe Incorporated v. Vysis, Inc.

Dear Tom:

Thank you for your letter of July 31, 2000, which summarizes our telephone conference of July 28, 2000. I write to add to the record several points not contained in your letter and to clarify certain aspects of your letter.

First, I wish to further elaborate on our discussions concerning the limiting language contained in Gen-Probe's responses to Vysis' document requests 3-5, 7, 9, 21, 23, and 42-43. Specifically, Gen-Probe agreed in its responses to produce all "a complete set of non-privileged design specification documents concerning the design and method of operation of such products." During our meet and confer, you asked whether Gen-Probe intended to produce design and specification documents with respect to each and every iteration of the HIV and HCV test kits or whether Gen-Probe's production would be limited to merely the final, commercialized versions of these products. As I explained, it is Gen-Probe's position that the only design and specification documents that are relevant are those that describe the HCV and HIV products that Gen-Probe has commercialized. Thus, Gen-Probe has agreed to produce and will produce documents so that Vysis may evaluate Gen-Probe's claim of non-infringement with respect to its commercial products. Gen-Probe will resist, however, Vysis' efforts to engage in a fishing expedition through Gen-Probe's sensitive and confidential research and development documents and materials, including its laboratory notebooks.

Next, I would like to confirm the agreements we reached with respect to Vysis and the third parties' (Banks; BP Amoco; Galloway; and Finnegan, Henderson) discovery responses. In regards to Vysis and the third parties' (collectively the "responding parties") "effective filing date" objection, the parties still harbor differing opinions about the relevancy of some later created documents. Nevertheless, the responding parties will respond to the affected document requests by producing all responsive documents created before December 21, 1987 and those responsive documents created after December 21, 1987 that refer to documents created or events that occurred before that date. Nothing herein shall be construed as a waiver of Gen-Probe's right to pursue discovery of documents created after December 21, 1987.

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**Cooley Godward LLP**

Thomas W. Banks, Esq.  
 August 3, 2000  
 Page Two

We also discussed Vysis' responses to Gen-Probe's interrogatories. With respect to interrogatory 2, you acknowledged our position that Gen-Probe is entitled to discover the facts that underlie Vysis' contention, which is set out in paragraph 1 of Vysis' Answer, that Gen-Probe's NAT test kits for the detection of HCV and HIV infringe the claims of the '338 patent. You responded, however, that you would need to discuss this issue further with Charlie Lipsey. Please let us know, as soon as possible, whether Vysis will voluntarily provide such a response. With respect to interrogatories 3 and 4, you agreed that Vysis would provide a further response that would set out at least the information contained in the reissue application. Please provide Vysis' amended responses to all of these interrogatories on or before Friday, August 11, 2000.

Finally, as you will recall, during our conversation, Matt Lehr and I advised you that there are several other discovery issues that we would raise by way of a letter. These issues are set forth below:

The third party witnesses have objected to producing documents that are owned by Vysis and have stated that the documents sought from them will be produced in response to the document requests propounded to Vysis. See e.g. Third Party Thomas W. Banks' Objections and Responses to Plaintiff Gen-Probe Incorporated's Subpoena for Production of Documents ("Banks' Subpoena Responses"), General Objection 8. Gen-Probe is entitled to know which of the various persons and entities from which it is seeking discovery are in possession of the documents sought. Thus, please ensure that each responding party produces all of the documents sought, irrespective of whether they are owned and produced by Vysis. Alternatively, we would be willing to consider accepting a collective, single set of Vysis' documents, so long as you also identify by bates number, at the time of production, which of those documents were in the possession of the various third parties at the time that service of Gen-Probe's subpoenas was deemed completed.

Vysis and the third party witnesses have objected to producing documents created after December 22, 1999, which is the date on which the Complaint was filed. See e.g. Banks' Subpoena Responses, General Objection 5. Gen-Probe does not seek to discover work-product documents created after this date or require that such documents be identified in a privilege log. Gen-Probe does request, however, that Vysis and the third parties produce any and all responsive documents that have been created in the ordinary course of business. Please ensure and confirm that all such documents are produced.

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**Cooley Godward LLP**

Thomas W. Banks, Esq.  
August 3, 2000  
Page Four

I sincerely hope that we can continue to work together to resolve these issues in an expeditious fashion. Please do not hesitate to contact us at you earliest convenience to discuss any of the issues identified above. Similarly, if I have misstated any aspect of our telephone conversation of Friday, July 28, 2000, please let me know.

Very sincerely,

Cooley Godward LLP



Patrick M. Maloney

PMM:lh

cc: Stephen P. Swinton, Esq.  
Matthew Lehr, Esq.

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**EXHIBIT G**

6/20

1 COOLEY GODWARD LLP  
STEPHEN P. SWINTON (106398)  
2 JAMES DONATO (146140)  
PATRICK M. MALONEY (197844)  
3 4365 Executive Drive, Suite 1100  
San Diego, CA 92121-2128  
4 Telephone: (858) 550-6000  
Facsimile: (858) 453-3555

5 R. WILLIAM BOWEN, JR. (102178)  
6 GEN-PROBE INCORPORATED  
10210 Genetic Center Drive  
7 San Diego, CA 92121-4362  
Telephone: (858) 410-8918  
8 Facsimile: (858) 410-8637

9 Attorneys for Plaintiff  
Gen-Probe Incorporated

11 UNITED STATES DISTRICT COURT  
12 SOUTHERN DISTRICT OF CALIFORNIA

14 GEN-PROBE INCORPORATED,  
15 Plaintiff,  
16 v.  
17 VYSIS, INC.,  
18 Defendant.

No. 99cv2668 H (AJB)

GEN-PROBE INCORPORATED'S RESPONSES TO  
VYSIS, INC.'S SECOND SET OF REQUESTS FOR  
PRODUCTION OF DOCUMENTS

20 **PROFOUNDING PARTY: DEFENDANT VYSIS, INC.**  
21 **RESPONDING PARTY: PLAINTIFF GEN-PROBE INCORPORATED**  
22 **SET NUMBER: TWO (2)**

23 Pursuant to Federal Rule of Civil Procedure 34, Plaintiff Gen-Probe Incorporated ("Gen-  
24 Probe") responds as follows to defendant Vysis, Inc.'s second set of requests for production of  
25 documents:

26 **I. GENERAL RESPONSES.**

27 1. Gen-Probe's response to defendant's first set of requests for production of documents is  
28 made to the best of Gen-Probe's current employees' present knowledge, information, and belief.

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1 Said response is at all times subject to such additional or different information that discovery or  
2 further investigation may disclose and, while based on the present state of Gen-Probe's  
3 recollection, is subject to such refreshing of recollection, and such additional knowledge of facts,  
4 as may result from its further discovery or investigation.

5 2. Gen-Probe reserves the right to make any use of, or to introduce at any hearing and at  
6 trial, documents responsive to defendant's first request for production but discovered subsequent  
7 to the date of Gen-Probe's initial production, including, but not limited to, any documents obtained  
8 in discovery herein.

9 3. Gen-Probe will respond to each document request with documents currently in Gen-  
10 Probe's possession, custody and control. By stating in these responses that Gen-Probe will  
11 produce documents or is searching for documents, Gen-Probe does not represent that any  
12 document actually exists, but rather that Gen-Probe will make a good faith search and attempt to  
13 ascertain whether documents responsive to defendant's request do, in fact, exist.

14 4. To the extent that Gen-Probe responds to defendant's document requests by stating that  
15 Gen-Probe will produce documents which it or any other party to this litigation deems to embody  
16 material that is private, business confidential, proprietary, trade secret or otherwise protected from  
17 disclosure pursuant to Federal Rule of Civil Procedure 26(c)(7), Federal Rule of Evidence 501,  
18 California Evidence Code section 1060, California Constitution, Article I, section 1, or any like or  
19 similar law of any jurisdiction, Gen-Probe will do so only upon the entry of an appropriate  
20 protective order.

21 5. Gen-Probe reserves the right to decide whether the documents produced for inspection  
22 shall be produced as they are kept in the usual course of business or shall be organized and labeled  
23 to correspond with the categories in defendant's request, in accordance with Federal Rule of Civil  
24 Procedure 34(b).

25 6. Gen-Probe reserves all objections or other questions as to the competency, relevance,  
26 materiality, privilege or admissibility as evidence in any subsequent proceeding in or trial of this or  
27 any other action for any purpose whatsoever of this response and any document or thing produced  
28 in response to defendant's request.



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1 Probe an obligation to investigate or discover information or materials from third parties or sources  
2 who are equally accessible to defendant.

3 5. Gen-Probe objects to all definitions, instructions, and document requests in which the  
4 phrase "relate to" or "relating to" appears. The terms "relate to" and "relating to" are overly  
5 broad, vague, ambiguous, and unintelligible, require subjective judgment on the part of Gen-Probe  
6 and Gen-Probe attorneys, and would require a conclusion or opinion of counsel in violation of the  
7 attorney work product doctrine. Without waiving this objection, and subject to all other applicable  
8 objections or privileges stated herein, Gen-Probe will produce, in response to any request for  
9 documents that "relate" to a given subject, such documents as expressly reflect or refer on their  
10 face to information relevant to the specified subject.

11 6. Gen-Probe objects to Definition C to the extent it defines "Gen-Probe" to include Gen-  
12 Probe's predecessors or successors; past or present divisions, subsidiaries, parents, or affiliates of  
13 any of the foregoing entities; past or present joint ventures, partnerships, or limited partnerships of  
14 which any of the foregoing entities is a joint venturer or a limited or general partner; and past or  
15 present directors, officers, employees, agents, or representatives of any of the foregoing entities.  
16 Said definition is vague and ambiguous in that it cannot be determined what is meant by the term  
17 "Gen-Probe." Said definition is also overly broad, seeks irrelevant information not calculated to  
18 lead to the discovery of admissible evidence, and would subject Gen-Probe and the other entities  
19 identified in the definition to unreasonable and undue annoyance, oppression, burden and expense.

20 7. Gen-Probe objects to Definition H to the extent that it defines the terms "product,"  
21 "products," "process" and "processes" in such a manner that they are interchangeable with one  
22 another and to the extent that said definition embraces products and processes other than those  
23 described in the operative pleading.

24 8. Gen-Probe further objects to Definition I to the extent that it defines the phrase "target  
25 capture" more broadly than technology taught by the '338 patent.

26 9. Gen-Probe objects to the Definitions, Instructions, and prefatory statement, on the  
27 ground that they seek unilaterally to impose an obligation to provide supplemental information  
28 greater than that required by the Federal Rules of Civil Procedure and would subject Gen-Probe to



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1 herein, each of the objections, Gen-Probe set forth in its responses to interrogatories 3 - 9, to the  
2 extent that this request incorporates those interrogatories by reference. Gen-Probe further objects  
3 to producing documents responsive to that portion of the request seeking documents "relied on in  
4 preparing, or relating to the subject matter of Gen-Probe's Responses to Vysis's Interrogatories 3-9  
5 to Gen-Probe" on the ground that such request expressly calls for the production of work product  
6 or other privileged information. Gen-Probe also objects that the term "subject matter of Gen-  
7 Probe's response" is vague and overbroad. Without waiving, and subject to, the foregoing  
8 objections, Gen-Probe will produce all non-privileged documents in its possession, custody and  
9 control to which it refers in its responses to Vysis's Interrogatories 3-9.

10 **DOCUMENT REQUEST NO. 3:**

11 All documents relating to, referring to, or describing any product or process for detecting  
12 and/or quantifying a polynucleotide using target capture and amplification developed by Gen-  
13 Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test  
14 kits for use in detecting HCV or HIV.

15 **RESPONSE TO DOCUMENT REQUEST NO. 3:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and  
17 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
18 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
19 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
20 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
21 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits  
22 for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all  
23 documents relating to, referring to, or describing" such products is overbroad and burdensome.  
24 Without waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set  
25 of non-privileged, design specification documents concerning the design and method of operation  
26 of such products.

27 **DOCUMENT REQUEST NO. 4:**

28 All documents constituting, referring to, or relating to instructions and/or manuals for any







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1 sale by Gen-Probe" of any such products is overbroad and burdensome. Without waiving, and  
2 subject to, the foregoing objections, Gen-Probe will produce a complete set of non-privileged,  
3 design specification documents concerning the design and method of operation of such products.

4 **DOCUMENT REQUEST NO. 8:**

5 All documents relating to, referring to, or describing any effort or attempt to design around  
6 the '338 patent.

7 **RESPONSE TO DOCUMENT REQUEST NO. 8:**

8 Gen-Probe incorporates into this response each of the foregoing General Responses and  
9 General Objections as if fully set forth herein. Gen-Probe further objects that this request is  
10 overbroad, unduly burdensome, and is not reasonably calculated to lead to the discovery of  
11 admissible evidence. Gen-Probe also objects that the term "design around" is vague and  
12 ambiguous leaving Gen-Probe to guess as to its meaning. Without waiving, and subject to, the  
13 foregoing objections, Gen-Probe states that it does not possess any non-privileged documents that  
14 are responsive to this request.

15 **DOCUMENT REQUEST NO. 9:**

16 All documents relating to, referring to, or describing comparisons between Gen-Probe's  
17 NAT test kits for use in detecting HCV or HIV and any potentially competing product or process  
18 not within the scope of the claims of the '338 patent.

19 **RESPONSE TO DOCUMENT REQUEST NO. 9:**

20 Gen-Probe incorporates into this response each of the foregoing General Responses and  
21 General Objections as if fully set forth herein. Gen-Probe further objects that the language  
22 "potentially competing product or process not within the scope of the claims of the '338 patent" is  
23 vague and ambiguous. Gen-Probe further objects that this request calls for legal conclusions  
24 concerning the construction of the claims of the '338 patent and the products or processes that  
25 Vysis contends are not within the claims of the '338 patent. Gen-Probe further objects that this  
26 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery  
27 of admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe will  
28 produce a complete set of non-privileged, design specification documents concerning the design





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1 advance at trial before the completion of investigation and discovery. In response to this request  
2 and at present time, Gen-Probe will produce those documents that are also responsive to Vysis'  
3 document requests 1-3, 6, 9, 11, 16, 24 and 32 and respond to interrogatories 1-3, 7, and 9. Upon  
4 satisfactory progress of discovery, Gen-Probe will produce all documents then within its  
5 possession, custody and control that are responsive to Vysis' requests for such contention  
6 discovery.

7 **DOCUMENT REQUEST NO. 15:**

8 All documents on which Gen-Probe relies for its contention that the '338 patent is invalid  
9 under 35 U.S.C. §§ 102 or 103.

10 **RESPONSE TO DOCUMENT REQUEST NO. 15:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and  
12 General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all  
13 documents "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney  
14 work product and privileged attorney client communications. Gen-Probe further objects to this  
15 interrogatory to the extent that it prematurely seeks the facts and contentions that Gen-Probe will  
16 advance at trial before the completion of investigation and discovery. In response to this request  
17 and at present time, Gen-Probe will produce those documents that are also responsive to Vysis'  
18 document requests 1-3, 6, 9, 11, 16, 24, and 32 and respond to interrogatory 1. Upon satisfactory  
19 progress of discovery, Gen-Probe will produce all documents then within its possession, custody  
20 and control that are responsive to Vysis' requests for such contention discovery.

21 **DOCUMENT REQUEST NO. 16:**

22 All documents referring to, relating to, constituting or describing prior art searches with  
23 respect to the subject matter of the '338 patent or the results of such searches.

24 **RESPONSE TO DOCUMENT REQUEST NO. 16:**

25 Gen-Probe incorporates into this response each of the foregoing General Responses and  
26 General Objections as if fully set forth herein. Gen-Probe further objects to this interrogatory to  
27 the extent that it prematurely seeks the facts and contentions that Gen-Probe will advance at trial  
28 before the completion of investigation and discovery. Gen-Probe further objects to this request to

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1 the extent that it the criteria employed when searching for prior art constitutes attorney work  
2 product. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce all  
3 non-privileged, prior art references within its possession, custody, and control.

4 **DOCUMENT REQUEST NO. 17:**

5 All documents referring or relating to the scope, meaning, or construction of any claim of  
6 the '338 patent.

7 **RESPONSE TO DOCUMENT REQUEST NO. 17:**

8 Gen-Probe incorporates into this response each of the foregoing General Responses and  
9 General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all  
10 documents referring or relating to the scope, meaning, or construction of any claim of the '338  
11 patent expressly requires the disclosure of attorney work product and privileged attorney client  
12 communications. Gen-Probe further objects to this interrogatory to the extent that it prematurely  
13 seeks the facts and contentions that Gen-Probe will advance at trial before the completion of  
14 investigation and discovery. In response to this request, at present time, and without waiving, and  
15 subject to, the foregoing objections, Gen-Probe will produce those non-privileged documents that  
16 are also responsive to Vysis' document requests 1-3, 6, 9, 11, 16, 24, and 32 and respond to  
17 interrogatories 1 and 2. Upon satisfactory progress of discovery, Gen-Probe will produce all non-  
18 privileged documents then within its possession, custody and control in response to this request.

19 **DOCUMENT REQUEST NO. 18:**

20 All documents referring to, relating to, or constituting any infringement, non-infringement,  
21 validity, invalidity, enforceability, or unenforceability analysis of the '338 patent.

22 **RESPONSE TO DOCUMENT REQUEST NO. 18:**

23 Gen-Probe incorporates into this response each of the foregoing General Responses and  
24 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing  
25 objections, Gen-Probe states that it does not possess any non-privileged documents that are  
26 responsive to this request.

27 **DOCUMENT REQUEST NO. 19:**

28 All documents referring to, relating to, or describing any decision about whether to obtain a

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1 legal opinion relating to the '338 patent.

2 **RESPONSE TO DOCUMENT REQUEST NO. 19:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and  
4 General Objections as if fully set forth herein. Gen-Probe further objects that the term "legal  
5 opinion" is vague and ambiguous leaving Gen-Probe to guess as to its meaning. Without waiving,  
6 and subject to, the foregoing objections, Gen-Probe states that it does not possess any non-  
7 privileged documents that are responsive to this request.

8 **DOCUMENT REQUEST NO. 20:**

9 All documents referring to, relating to, describing, or constituting procedures, policies,  
10 guidelines, training materials, or recommended courses of action concerning third-party patents.

11 **RESPONSE TO DOCUMENT REQUEST NO. 20:**

12 Gen-Probe incorporates into this response each of the foregoing General Responses and  
13 General Objections as if fully set forth herein. Gen-Probe further objects that this request is  
14 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of  
15 admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe states  
16 that it does not possess any non-privileged documents that are responsive to this request.

17 **DOCUMENT REQUEST NO. 21:**

18 All documents referring to, relating to, or describing the use or prospective use of any  
19 teaching contained in the '338 patent in the design or development of any product or process for  
20 detecting and/or quantifying a polynucleotide using target capture and amplification developed by  
21 Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe NAT  
22 test kit for use in detecting HCV or HIV.

23 **RESPONSE TO DOCUMENT REQUEST NO. 21:**

24 Gen-Probe incorporates into this response each of the foregoing General Responses and  
25 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
26 and ambiguous with respect to the terms "amplification" and "teaching." Gen-Probe further  
27 objects that this request is phrased in an argumentative manner that assumes facts not in evidence.  
28 Gen-Probe still further objects that this request requires Gen-Probe to guess as to the "teaching"



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1 purportedly contained in the '338 patent. Gen-Probe also objects that to the extent this request  
2 seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting  
3 HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead  
4 to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits for use in detecting  
5 HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all documents  
6 referring to, relating to, or describing the use or prospective use of any teaching contained in the  
7 '338 patent" is overbroad and burdensome. Without waiving, and subject to, the foregoing  
8 objections, and without any agreement or acknowledgement as to the "teaching" of the '338 patent  
9 or the use or prospective use of the same, Gen-Probe will produce a complete set of non-  
10 privileged, design specification documents concerning the design and method of operation of such  
11 products.

12 **DOCUMENT REQUEST NO. 22:**

13 All documents referring to, relating to, or describing the circumstances under which Gen-  
14 Probe first became aware of the '338 patent.

15 **RESPONSE TO DOCUMENT REQUEST NO. 22:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and  
17 General Objections as if fully set forth herein. Gen-Probe further objects that this request is  
18 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of  
19 admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe  
20 produce all non-privileged, responsive documents within its possession, custody and control.

21 **DOCUMENT REQUEST NO. 23:**

22 All documents referring to, relating to, or describing products or processes for detecting  
23 and/or quantifying a polynucleotide using target capture and amplification developed by Gen-  
24 Probe, either by itself or with another person, including but not limited to all documents referring  
25 to, relating to, describing or constituting a study or analysis of those products or processes in  
26 relation to the '338 patent.

27 **RESPONSE TO DOCUMENT REQUEST NO. 23:**

28 Gen-Probe incorporates into this response each of the foregoing General Responses and

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1 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting  
2 HCV or HIV.

3 **RESPONSE TO DOCUMENT REQUEST NO. 25:**

4 Gen-Probe incorporates into this response each of the foregoing General Responses and  
5 General Objections as if fully set forth herein. Gen-Probe further objects that this request seeks  
6 documents that may be protected by the confidentiality interests of third parties. Gen-Probe also  
7 objects that to the extent this request seeks documents relating to products other than Gen-Probe's  
8 NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and  
9 is not reasonably calculated to lead to the discovery of admissible evidence. Gen-Probe further  
10 objects that this request is vague and ambiguous with respect to the term "amplification." Without  
11 waiving, and subject to, the foregoing objections, Gen-Probe will produce any non-privileged,  
12 responsive documents within its possession, custody, and control.

13 **DOCUMENT REQUEST NO. 26:**

14 All documents referring to, relating to, describing or constituting communications between  
15 Gen-Probe and third parties relating to this litigation.

16 **RESPONSE TO DOCUMENT REQUEST NO. 26:**

17 Gen-Probe incorporates into this response each of the foregoing General Responses and  
18 General Objections as if fully set forth herein. Gen-Probe further objects that this request seeks  
19 documents that may be protected by the confidentiality interests of third parties and may also be  
20 protected by community of interests in applicable attorney-client privileged communications and  
21 attorney work product. Furthermore, Gen-Probe objects to producing or identifying  
22 communications occurring after the initiation of the litigation between it and third parties  
23 concerning this litigation on the grounds of the attorney-client privilege and attorney work product.  
24 Without waiving, and subject to, the foregoing objections, Gen-Probe states that it does not  
25 possess any non-privileged documents responsive to this request that pre-date this litigation.

26 **DOCUMENT REQUEST NO. 27:**

27 All documents referring to, relating to, or describing the need for or desirability of Gen-  
28 Probe's taking a license under the '338 patent, or Gen-Probe's decision regarding whether or not to

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1 take a license under the '338 patent.

2 **RESPONSE TO DOCUMENT REQUEST NO. 27:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and  
4 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing  
5 objections, Gen-Probe states that it does not possess any non-privileged documents that are  
6 responsive to this request.

7 **DOCUMENT REQUEST NO. 28:**

8 All documents referring to, relating to, or describing Gen-Probe's decision whether or not  
9 to institute this action against Vysis.

10 **RESPONSE TO DOCUMENT REQUEST NO. 28:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and  
12 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing  
13 objections, Gen-Probe states that it does not possess any non-privileged documents that are  
14 responsive to this request.

15 **DOCUMENT REQUEST NO. 29:**

16 All documents Gen-Probe believes support its unfair competition claim.

17 **RESPONSE TO DOCUMENT REQUEST NO. 29:**

18 Gen-Probe further objects to this request to the extent that it calls for the disclosure of  
19 attorney work product. Gen-Probe further objects that Vysis' requests that seek all documents  
20 "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney work product  
21 and privileged attorney client communications. Gen-Probe further objects to this request to the  
22 extent that it prematurely seeks the facts and contentions that Gen-Probe will advance at trial  
23 before the completion of investigation and discovery. Upon satisfactory progress of discovery,  
24 Gen-Probe will agree to produce all non-privileged documents response to Vysis' request.  
25 Without waiving and subject to the foregoing objections, Gen-Probe will produce documents  
26 responsive to Vysis' requests document requests 1-3, 6, 9, 11, 16, 24 and 32, and interrogatories 1-  
27 3, 7, and 9.

28 **///**

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1 **DOCUMENT REQUEST NO. 30:**

2 Documents sufficient to describe the corporate and organizational structure of Gen-Probe  
3 Incorporated for each year since 1990.

4 **RESPONSE TO DOCUMENT REQUEST NO. 30:**

5 Gen-Probe incorporates into this response each of the foregoing General Responses and  
6 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing  
7 objections, Gen-Probe will produce documents that describe its corporate and organizational  
8 structure.

9 **DOCUMENT REQUEST NO. 31:**

10 Documents sufficient to identify all employees, attorneys, officers, consultants or other  
11 persons involved in the research, development, testing, evaluation, manufacture, marketing, sale,  
12 or servicing of any product or process for detecting and/or quantifying a polynucleotide using  
13 target capture and amplification developed by Gen-Probe, either by itself or with another person,  
14 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

15 **RESPONSE TO DOCUMENT REQUEST NO. 31:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and  
17 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this  
18 request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
19 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
20 calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this  
21 request is vague and ambiguous with respect to the term "amplification." Without waiving, and  
22 subject to, the foregoing objections, Gen-Probe will prepare and produce a list identifying the  
23 persons principally involved with Gen-Probe's NAT test kits for detecting HCV and HIV.

24 **DOCUMENT REQUEST NO. 32:**

25 All documents relating to correspondence or communications between Gen-Probe and  
26 Vysis relating to the '338 patent or any product or process for detecting and/or quantifying a  
27 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or  
28 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting



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1 **DOCUMENT REQUEST NO. 34:**

2 All documents referring to, relating to, describing or constituting sales of any product or  
3 process for detecting and/or quantifying a polynucleotide using target capture and amplification  
4 developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-  
5 Probe's NAT test kits for use in detecting HCV or HIV.

6 **RESPONSE TO DOCUMENT REQUEST NO. 34:**

7 Gen-Probe incorporates into this response each of the foregoing General Responses and  
8 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
9 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
10 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
11 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
12 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits  
13 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not  
14 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and  
15 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and  
16 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

17 **DOCUMENT REQUEST NO. 35:**

18 All documents referring to, relating to, or describing the price of any product or process for  
19 detecting and/or quantifying a polynucleotide using target capture and amplification developed by  
20 Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT  
21 test kits for use in detecting HCV or HIV.

22 **RESPONSE TO DOCUMENT REQUEST NO. 35:**

23 Gen-Probe incorporates into this response each of the foregoing General Responses and  
24 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
25 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
26 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
27 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
28 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits

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1 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not  
2 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and  
3 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and  
4 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

5 **DOCUMENT REQUEST NO. 36:**

6 All documents referring to, relating to, or describing the costs associated with any product  
7 or process for detecting and/or quantifying a polynucleotide using target capture and amplification  
8 developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-  
9 Probe's NAT test kits for use in detecting HCV or HIV.

10 **RESPONSE TO DOCUMENT REQUEST NO. 36:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and  
12 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
13 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
14 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
15 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
16 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits  
17 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not  
18 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and  
19 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and  
20 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

21 **DOCUMENT REQUEST NO. 37:**

22 All documents referring to, relating to, or describing the profits (gross and net) made on the  
23 sale of any product or process for detecting and/or quantifying a polynucleotide using target  
24 capture and amplification developed by Gen-Probe, either by itself or with another person,  
25 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

26 **RESPONSE TO DOCUMENT REQUEST NO. 37:**

27 Gen-Probe incorporates into this response each of the foregoing General Responses and  
28 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague



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1 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
2 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
3 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
4 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits  
5 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not  
6 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and  
7 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and  
8 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

9 **DOCUMENT REQUEST NO. 38:**

10 All documents referring to, relating to, or describing any licenses, agreements, or contracts  
11 involving any product or process for detecting and/or quantifying a polynucleotide using target  
12 capture and amplification developed by Gen-Probe, either by itself or with another person,  
13 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

14 **RESPONSE TO DOCUMENT REQUEST NO. 38:**

15 Gen-Probe incorporates into this response each of the foregoing General Responses and  
16 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this request  
17 seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting  
18 HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead  
19 to the discovery of admissible evidence. Gen-Probe further objects that this request is vague and  
20 ambiguous with respect to the term "amplification." Without waiving, and subject to, the  
21 foregoing objections, Gen-Probe will produce a copy of the license and collaboration agreements  
22 with Chiron and Bayer concerning Gen-Probe's NAT test kits for use in detecting HCV and HIV.

23 **DOCUMENT REQUEST NO. 39:**

24 All documents referring to, relating to, or describing any payments paid or received in  
25 relation to any product or process for detecting and/or quantifying a polynucleotide using target  
26 capture and amplification developed by Gen-Probe, either by itself or with another person,  
27 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

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1 **RESPONSE TO DOCUMENT REQUEST NO. 39:**

2 Gen-Probe incorporates into this response each of the foregoing General Responses and  
3 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
4 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent  
5 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
6 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
7 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits  
8 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not  
9 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and  
10 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and  
11 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

12 **DOCUMENT REQUEST NO. 40:**

13 All documents referring to, relating to, describing or constituting business plans, marketing  
14 plans or studies, and projections for any product or process for detecting and/or quantifying a  
15 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or  
16 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting  
17 HCV or HIV.

18 **RESPONSE TO DOCUMENT REQUEST NO. 40:**

19 Gen-Probe incorporates into this response each of the foregoing General Responses and  
20 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this  
21 request seeks documents relating to products other than Gen-Probe's NAT test kits for use in  
22 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably  
23 calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this  
24 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery  
25 of admissible evidence. Gen-Probe further objects that this request is vague and ambiguous with  
26 respect to the term "amplification." Without waiving, and subject to, the foregoing objections,  
27 Gen-Probe will produce all non-privileged marketing plans concerning Gen-Probe's NAT test kits  
28 for use in detecting HCV and HIV.



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1 of admissible evidence. Without waiving and subject to the foregoing objections, Gen-Probe will  
2 produce a complete set of non-privileged, design specification documents concerning the design  
3 and method of operation of Gen-Probe's NAT test kits for use in detecting HCV or HIV.

4 **DOCUMENT REQUEST NO. 43:**

5 All documents relating to any investigational purpose associated with any sale or offer to  
6 sell any goods or services relating to a product or process for detecting and/or quantifying a  
7 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or  
8 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting  
9 HCV or HIV, including any document reflecting the nature of any information to be gathered, any  
10 obligation to report results by Gen-Probe, any limitations on the nature or extent of the use to  
11 which the product may be put by the purchaser, and any anticipated future commercial benefit  
12 from providing such goods or services to customers.

13 **RESPONSE TO DOCUMENT REQUEST NO. 43:**

14 Gen-Probe incorporates into this response each of the foregoing General Responses and  
15 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
16 and ambiguous with respect to the term "amplification." Gen-Probe further objects that the term  
17 "investigational purpose associated with any sale or offer to sell any goods or services relating to a  
18 product or process for detecting and/or quantifying a polynucleotide using target capture and  
19 amplification" is vague and ambiguous leaving Gen-Probe to guess as to its meaning. Without  
20 waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set of non-  
21 privileged, design specification documents concerning the design and method of operation of Gen-  
22 Probe's NAT test kits for use in detecting HCV or HIV and the non-privileged books and records  
23 subject to paragraph 3.9 of the parties' license agreement concerning the '338 patent.

24 **DOCUMENT REQUEST NO. 44:**

25 All documents evidencing, relating, or referring to the efficacy, efficiency, cost, speed,  
26 accuracy, or desirability of assays or methods for detecting and or quantifying a polynucleotide  
27 involving either target capture or amplification but not both.

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1 amplification technique in assays or methods for detecting or quantifying a polynucleotide.

2 **RESPONSE TO DOCUMENT REQUEST NO. 46:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and  
4 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague  
5 and ambiguous with respect to the term "amplification." Gen-Probe further objects that this  
6 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery  
7 of admissible evidence. Gen-Probe further objects to this request to the extent that it prematurely  
8 seeks the facts and contentions that Gen-Probe may advance at trial before the completion of  
9 investigation and discovery. Gen-Probe further objects that this request is temporally overbroad to  
10 the extent that it seeks documents created after the effective filing date of the application that led  
11 to the '338 patent. Subject to the temporal limitation and without waiving, and subject to, the  
12 other foregoing objections, Gen-Probe will produce non-privileged, responsive documents in its  
13 possession, custody and control, that otherwise may constitute prior art.

14 **DOCUMENT REQUEST NO. 47:**

15 All documents evidencing, relating, or referring to the feasibility of cell-free protein  
16 expression as an amplification technique in assays or methods for detecting or quantifying a  
17 polynucleotide.

18 **RESPONSE TO DOCUMENT REQUEST NO. 47:**

19 Gen-Probe incorporates into this response each of the foregoing General Responses and  
20 General Objections as if fully set forth herein. Gen-Probe further objects that this request is  
21 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of  
22 admissible evidence. Gen-Probe further objects that this request is vague and ambiguous with  
23 respect to the term "amplification." Gen-Probe further objects to this request to the extent that it  
24 prematurely seeks the facts and contentions that Gen-Probe may advance at trial before the  
25 completion of investigation and discovery. Gen-Probe further objects that this request is  
26 temporally overbroad to the extent that it seeks documents created after the effective filing date of  
27 the application that led to the '338 patent. Subject to the temporal limitation and without waiving,  
28 and subject to, the other foregoing objections, Gen-Probe will produce non-privileged, responsive

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